

## DRAWINGS

The attached sheet of drawings includes changes to FIG. 5. This sheet, which includes FIG. 5, replaces the original sheet including FIG. 5. In FIG. 5, the reference "Stock\_en" has been replaced with "Stack\_en".

Attachment: Replacement Sheet (1 Sheet)

## REMARKS

Claims 1-36 are pending in the present application. The Examiner has rejected claims 1-36.

### I. OBJECTION WITH RESPECT TO DRAWINGS

The Examiner has objected to the drawings for noted informalities. In particular, the Examiner has noted that "Stock\_en" should be replaced with "Stack\_en" in FIG. 5. Applicant has amended FIG. 5. The amended FIG. 5 has been attached and labeled "Replacement Sheet". It is therefore respectfully requested that the objection be withdrawn with respect to the drawings.

### II. PRIMA FACIE CASE OF OBVIOUSNESS

Claims 1-36 stand rejected under 35 U.S.C. § 103(a) as being obvious over United States Patent No. 4,607,345 ("Mehta"). Applicant traverses the rejection as set forth below.

Applicant respectfully requests that the next Office Action, if necessary, more clearly demonstrate a *prima facie* case of obviousness. M.P.E.P. § 2142 states that

[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

In particular, Applicant respectfully requests that the next Office Action discuss each and every element as set forth by the claims. M.P.E.P. § 2142 states that

[t]o establish a *prima facie* case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant respectfully submits that the Office Action does not present a *prima facie* case of obviousness because the Office Action does not consider each and every element as set forth in the claims. For example, instead of discussing each and every element as set forth in claim 1 and each and every element as set forth in claim 19, the Office Action instead takes the extraordinary step of discussing the elements as set forth in claim 1 of the prior art reference, Mehta. Thus, the Office Action does not consider each and every element of claim 1 and each and every element of claim 19. Accordingly, for at least the above reasons, a *prima facie* case of obviousness has not been established.

Furthermore, the Office Action allegedly summarizes the elements as set forth in claims 1 and 19 in a mere four (4) lines and then concludes, in a conclusory statement, that Mehta teaches substantially the summarized elements. Office Action at pages 3 and 4. Applicant respectfully challenges the replacement of each and every element as set forth in claim 1 and each and every element as set forth in claim 19 with mere summarized elements. Applicant further respectfully challenges the case of obviousness presented in the Office Action since the presented case does not discuss each and every element as set forth in claim 1 and each and every element as set forth in claim 19.

M.P.E.P. § 2141.02 states that

[a]scertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole.

However, M.P.E.P. § 2141.02 further states that

[d]istilling an invention down to the “gist” or “thrust” of an invention disregards the requirement of analyzing the subject matter “as a whole”.

Thus, by merely summarizing the elements of claims 1 and 19, the Office Action impermissibly distills the invention down to the gist or thrust of the invention and disregards. For at least the above reasons, Applicant respectfully submits that a *prima facie* case of obviousness has not been presented.

In lumping claims 1 and 19 into a single analysis based on summarized elements, the Office Action does not acknowledge or consider the differing elements between claim 1 and claim 19. Applicant respectfully requests that the subsequent Office Action, if necessary, address and consider, with specificity, the differences between the elements as set forth in claim 1 and the elements as set forth in claim 19.

Applicant respectfully submits that, since the Office Action does not present a *prima facie* case of obviousness with respect to claims 1 and 19, the Office Action does not present a *prima facie* case of obviousness with respect to claims 1 and 19 and their respective dependent claims (i.e., claims 2-8 and claims 20-26).

Since the Office Action merely supports the rejection of claims 9-18 and claims 27-36 by referencing the arguments made with respect to claims 1-9 and claims 19-26, the Office Action cannot maintain a *prima facie* case of obviousness with respect to claims 9-18 and claims 27-36.

Accordingly, Applicant respectfully submits that the Office Action does not present a *prima facie* case of obviousness with respect to claims 9-18 and claims 27-36.

In accordance with M.P.E.P. § 2142, since the Examiner has not produced a *prima facie* case of obviousness, Applicant is under no obligation to submit evidence of nonobviousness. Applicant respectfully submits that the Office Action does not present a *prima facie* case of obviousness with respect to claims 1-36.

### **III. FORMAL REQUEST FOR REFERENCES TO SUPPORT STATEMENTS**

With respect to claims 2 and 20, the Examiner alleges, without any supporting evidence, that "one of ordinary skill in the art would have recognized that a plurality of cycles of clock signal are needed for storing a plurality of bits of serial data". Office Action at page 4.

With respect to claims 3, 4, 21 and 22, the Examiner alleges, without any supporting evidence, that "one of ordinary skill in the art would have recognized that n bits of data arranged to store in a memory in parallel fashion would need only one clock cycle". Office Action at page 4.

With respect to claims 8 and 26, the Examiner alleges, without any supporting evidence, that "it is a matter of design choice to implement the number of flip-flops to be three or less depends on the number of bits received". Office Action at page 4.

Applicant respectfully challenges the conclusory assertions made in the Office Action that the elements recited in claims 2-4, 8, 20-22 and 26 are well known in the art or are obvious in the art. Applicant respectfully submits that, in the context of the elements as recited in independent claim 1 and independent claim 19, the elements in claims 2-4 and 8 and claims 20-22 and 26, respectively, are not well known or obvious. Furthermore, on a claim-by-claim basis, Applicant respectfully requests that the Examiner provide an explanation as to the obviousness of combining the elements recited in claims 2-4 and 8 and claims 20-22 and 26 with the elements recited in claim 1 and claim 19, respectively. In addition, Applicant respectfully requests that the Examiner provide an explanation for modifying Mehta with the elements as set forth in claims 2-4, 8, 20-22 and 26. To wit, it is respectfully requested that the Examiner avoid supporting an obviousness conclusion with improper hindsight reasoning. See, e.g., M.P.E.P. § 2145(X)(A).

M.P.E.P. § 2144.03(E) clearly states that

[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Accordingly, Applicant respectfully submits that, in order to maintain the obviousness rejection, the Examiner either must produce references in support of the Examiner's contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2).

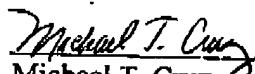
#### IV. CONCLUSION

In view of at least the foregoing, it is respectfully submitted that the pending claims 1-36 are in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Dated: February 10, 2005

Respectfully submitted,

  
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